

## **REMARKS**

### **Claim Amendment**

Claims 18-24 and 27 are pending in the application. Claim 18 has been amended to recite that the compound comprising the immunomodulatory moiety is 12 to 35 nucleotides in length and does not have antisense activity. Support for this amendment can be found throughout the specification for example, at paragraph [0032] and paragraph [0024] of the specification as published. No new matter has been added.

### **Rejection of Claims 18-24 and 27 Under 35 U.S.C. §112, First Paragraph**

Claims 23-23 are rejected under 35 U.S.C. §112, first paragraph, because, according to the Office Action, the specification does not reasonably provide enablement to use the invention commensurate in scope with the currently pending claims.

Applicants respectfully disagree. Applicants submit that one skilled in the art would be taught by the specification how to practice the claimed invention without undue experimentation. One skilled in the art could easily reproduce the results disclosed in the specification by simply following its disclosed teachings and examples. As to other oligonucleotides, undoubtedly some screening using the instant teachings would be required. However, these experiments, which would require no modification of the instant teachings, would not be undue. The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *Massachusetts Institute of Technology v. A.B. Fortia*, 227 U.S.P.Q. 428 (Fed. Cir. 1985). In this field, scientists typically engage in such screening, and would have to do so no matter how many oligonucleotides are exemplified. In addition, the enablement requirement is met if the description enables any mode of making and using the invention. *Johns Hopkins University v. Cell Pro Inc.*, 47 U.S.P.Q.2d 1705, 1718 (Fed. Cir. 1998), *citing Engel Indus., Inc. v. Lockformer Co.*, 20 U.S.P.Q.2d 1300, 1304 (Fed. Cir. 1991). Applicant has clearly met this requirement.

Additionally, although the Office Action correctly states that Yu et al. shows that the position of immunomodulatory moieties in relation to the CpG dinucleotide are critical to immunostimulatory function, Yu et al. is a publication by the instant inventors showing further data based on the teachings of the instant specification. As such, Yu et al. supports the instant claims and demonstrates that one skilled in the instant art would typically engage in such

experimentation and that it is not undue. Reconsideration and withdrawal of the rejection are requested.

**CONCLUSION**

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

Dated: May 11, 2006  
Keown & Associates  
500 West Cummings Park  
Suite 1200  
Woburn, MA 01801  
Telephone: 781/938-1805  
Facsimile: 781/938-4777

By /Joseph C. Zuccherio/  
Joseph C. Zuccherio  
Registration No. 55,762